REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Claim Amendments

Claims 35 and 42 have been amended to correct the inadvertent inclusion of two periods at the end of each claim, and to add the word –an– before "area" in claim 42.

Because these changes are clearly formal in nature, it is respectfully submitted that they do not raise new issues or introduce new matter into the disclosure. Entry of the amendments is accordingly requested.

2. Rejection of Claims 1-3, 8-11, 21, 22, 26-29, 35, and 36 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier) and 5,848,412 (Rowland)

This rejection is respectfully traversed on the grounds that the Auxier and Rowland patents fail to disclose or suggest **banner ads** that **block** access to an address, service, or content, *i.e.*, to a *user-requested* web page, unless an appropriate response to the ad is made by the user. Instead:

- the Auxier patent teaches interactive banner ads that re-direct users *away from the requested address, service, or content* to the sponsor of the ad if a response is made, rather than to the address, service, or content requested by the user; and
- the Rowland patent teaches a way to have the user's computer directly provide identification information requested by a website, *without* the need for the user to personally enter any information, and in particular a way to control such provision of identification information without the security risks associated with conventional cookies, which does not involve presentation of banner ads and has nothing to do with response to a banner ad.

The Rowland patent neither discloses nor suggests that the concept of protecting identification information (in effect, the provision of user-secured cookies) should be utilized to force users to

respond to banner ads, and there is clearly no motivation in either the Auxier or Rowland patents to apply the password-storage teachings of Rowland to banner ads of the type disclosed by Auxier.

As noted in the previous response, the Auxier patent teaches the opposite of the claimed invention. Whereas Auxier teaches use of banner ads to direct users ***away from*** a desired website if the users respond to the ad, the claimed invention uses banner ads to grant users ***access to*** the desired website, but only if they respond to the ad.

Furthermore, the Rowland patent also teaches away from the claimed invention. Whereas the claimed invention presents a banner ad to the user and requires the *user* to enter information, indicating that the user has read the banner ad, Rowland is concerned with enabling a user to access a website WITHOUT having to enter information, the identification information instead being transferred directly from the user's computer to the website. This does not involve banner ads or even dialog boxes, but rather seeks to eliminate the task of having to enter the identification information each time the website is accessed.

Nothing in the Rowland patent suggests changing this usual function of banner ads so as to control access to a requested website, as opposed to directing users away from the desired website. The Rowland patent does not concern any sort of banner advertisement, or getting users to acknowledge the content of the banner advertisement, but rather concerns collection of identification information. In fact, the Rowland patent does not even concern the method by which the *website* collects information, but rather concerns storage of identification information on the user's computer. ***The basic principle taught in the Rowland patent involves simplifying access to websites by having the user assign passwords or other identification information different security levels and directly providing the information to a requesting website based on the security level.*** According to the Rowland patent, a user can provide information to access a website without ever having to input any information into a dialog box.

A system that stores information and provides it to a requesting website does not suggest modification of the banner ad server of Auxier to block access to a website unless a user responds to the ad. The focus of the Rowland patent is on user control of information provided to websites, and not on forcing a user to respond to a banner ad, or even a dialog box, before the user can access the site. Requested websites are not blocked unless a user inputs a response.

The primary consideration for a server of banner ads, as in the Auxier patent, is to get the user to read the ad. An advertisement is useless if it is not read. The claimed invention addresses this problem by presenting a banner ad similar to the ads of Auxier, but arranged to block access to the site unless a response is made, rather than directing the user to another site if a response is made. Nothing in Rowland suggests modification of the arrangement of Auxier to grant access to the requested if a response is made, rather than directing users to another site. The user will still be directed away from the requested site if the user responds to the banner ad of Auxier, even if the user includes Rowland's identification information control on his or her computer.

It is important to emphasize that references applied under 35 USC §103(a) must be considered in the manner that the ordinary artisan would have considered them, *i.e.*, as a whole, without the benefit of a template that would have caused the ordinary artisan to ignore the context and selected teachings of the individual references in order to make the combination. As explained in **MPEP 2143.02**:

> *If the proposed modification or combination of the prior art would* ***change the principle of operation of the prior art invention being modified****, then the teachings of the references are not sufficient to render the claims prima facie obvious* (citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)...*The court reversed the rejection holding the "suggested combination of references would require a* ***substantial reconstruction and redesign*** *of the elements shown in [the primary reference]* ***as well as a change in the basic principle under which the [primary reference] construction was designed to operate****" 123 USPQ at 352.* (See also, MPEP 2141.02, p. 2100-107 "**A prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention** (emphasis in the original).

It is respectfully submitted that any modification of the Auxier system that involves directing the

user to a requested site after responding to a banner ad, rather than directing the user away from the requested site, would indeed change the principle of operation of the prior art invention being modified.

While it is possible for a prior art reference to include a teaching that in fact would have caused the ordinary artisan to change the principle of operation of the prior invention, the Rowland patent does not include such a teaching. Rowland does not provide any reasons why a user shouldn't be directed to a sponsor's website when responding to a banner ad. Rowland merely teaches that if the user does wish to proceed to a requested website, he can control the information stored on his or her computer and used to access the site, without the risk of unlimited access provided by conventional "cookies" containing personal information. **In a way, Rowland merely teaches providing the user with control of cookie access. This has nothing to do with the claimed invention.**

As noted in the previous response, the nature of the "click-through" ads of Auxier, which direct (or block) access to a third party site different from the originally requested site, can be understood from the description in col. 3, lines 56-61 of the Auxier patent:

> *As noted, the banner ad is both an advertisement and a link to the merchant's web site. If the user viewing the web page that is displayed on client computer 130 find the banner ad appealing, the user can click on the banner ad and be transferred or linked to the merchant's website.*

The objective of Auxier's method is to enhance the click-through rate by making click through more fun. The user plays a game on the banner ad, which has the effect of clicking the user through to the ***sponsor's*** website. This is not how the claimed invention operates, and the Rowland patent does not include any teachings that would cause the ordinary artisan to modify this mode of operation. Instead, of providing an alternate click through path by enticing the viewer away from an intended website, the claimed invention blocks the path to the intended website and requesting interaction, *but once the interaction is complete*, the path is unblocked and the viewer proceeds to the intended website and not to a third party sponsor's website. The Rowland patent, on the other hand, provides a way for a user to control access to identification

information stored on the user's computer, with the user deciding whether access should be granted or not.

Because the Auxier and Rowland patents do not disclose or suggest, whether considered individually or in any reasonable combination, all elements recited in claims 1-3, 8-11, 21, 22, 26-29, 35, and 36, withdrawal of the rejection under 35 USC §103(a) is respectfully requested.

3. Rejection of Claims 7 and 25 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 5,848,412 (Rowland), and 6,286,045 (Griffiths)

This rejection is respectfully traversed on the grounds that the Griffiths patent, like the Auxier and Rowland patents, fails to disclose or suggest an interactive banner ad that blocks access to a requested website unless an appropriate response is made by the user, as opposed to merely seeking to entice a viewer to click through to a third party provider.

Instead, the Griffiths patent discloses a system for managing "banner ads," defined as "*any information displayed in conjunction with a web page wherein the information is not part of the same file as the web page*," by using a proxy server that enables an accurate count of the number of the times the ad has been presented, no matter what the source, and even if the ad is locally cached. Nowhere does the Griffiths patent disclose or suggest that the banner ads are presented in such a way that failure to respond to or interact with the ad will block access to a service, content, or address requested by the user.

Accordingly, withdrawal of the rejection of claims 7 and 25 under 35 USC §103(a) is requested.

4. Rejection of Claims 4-6, 12-15, 19, 20, 23, 24, 30, 31, 32, 37-39, and 42-49 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 5,848,412 (Rowland), and 6,011,537 (Slotznick)

This rejection is respectfully traversed on the grounds that the Slotznick patent, like the Auxier and Rowland patents, fails to disclose or suggest an interactive banner ad that blocks

access to a requested website unless an appropriate response is made by the user, as opposed to merely seeking to entice a viewer to click through to a third party provider.

The Slotznick patent merely discloses the well-known technique of presenting a banner ad when a user request access to content over a network. If the user fails to interact with the banner ad, the user is clearly not prevented from accessing the requested content. Neither the Auxier patent nor the Slotznick patent discloses or suggest permitting access to the requested content ***only if*** the user interacts with the banner ad, as claimed. Accordingly, withdrawal of the rejection of claims 4-6, 12-15, 19, 20, 23, 24, 30, 31, 32, 37-39, and 42-49 under 35 USC §103(a) is requested.

5. Rejection of Claims 16-18, 33, 34, 40, and 41 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,379,251 (Auxier), 5,848,412 (Rowland), 6,011,537 (Slotznick), and 6,011,537 (Eggleston)

This rejection is respectfully traversed on the grounds that the Eggleston patent, like the Slotznick, Auxier, and Rowland patents, fails to disclose or suggest an interactive banner ad that permits access to a requested website "only if" the user interacts with the banner ad, as opposed to merely seeking to entice a viewer to click through to a third party provider.

Instead, the Eggleston patent merely discloses an incentive system that provides rewards in the form of credits for viewing advertisements. The user is not required to interact with any particular ad in order to access a requested content.

Furthermore, according to one aspect of the method of the claimed invention, the user is rewarded for accumulating credits by **not** having to view the banner ad in order to access the requested content, and according to another aspect of the claimed invention, the credits are applied to a subscription of the content requested. The incentive of **not** having to view banner ads or of reducing subscription costs for content accessed upon interaction with a banner ad is not even remotely suggested by the Eggleston, Slotznick, Rowland, and Auxier patents, whether considered individually or in any reasonable combination.. Accordingly, withdrawal of the

rejection of claims 16-18, 33, 34, 40, and 41 under 35 USC §103(a) is requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

By: BENJAMIN E. URCIA
Registration No. 33,805

Date: August 18, 2004

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314

Telephone: (703) 683-0500

NWB:S:\Producer\beu\Pending I...P\K\KONTOGOURIS742438\a02.wpd